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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/587,058	06/02/2000	Bernhard Schierling	4452-195RE	6846

.7590 02/20/2002

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EXAMINER

BONCK, RODNEY H

ART UNIT

PAPER NUMBER

3681

DATE MAILED: 02/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/587,058

Applicant(s)

SCHIERLING, BERNHARD

Examiner

Rodney H. Bonck

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-4 is/are allowed.
- 6) ☒ Claim(s) 5-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 June 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 08/625,759.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

DETAILED ACTION

The following action is in response to the Request for Continued Examination received January 16, 2002. The proposed amendment received October 3, 2001, entry of which was previously denied, has now been entered.

Reissue Applications

The specification is objected to because it fails to correctly incorporate the changes made by the Certificate of Correction in the original patent. See MPEP 1411.01. This objection was made in Paper No. 4 and applicant submitted a new substitute specification. In reviewing the new specification, however, it was noted that the change in column 6, line 59, was not incorporated into the specification. In column 6, line 59, "DE-08" should be – DE-OS --. This change should be added to the specification without underlining and bracketing because this is part of the original patent and the change was made before the reissue was filed.

Claim 8 is rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ

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289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue, which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

With regard to the insulating member, claim 8 appears to be substantially of the same scope as claim 21, which was canceled in the application for the patent upon which this reissue is based. In particular, claim 21 recited "said insulating member being rigid" and "said insulating member comprising a metal; and said metal of said insulating member being configured to minimize heat conduction from said pressure plate to said membrane spring ...". Claim 8 of the instant application includes the recitation "said insulating member being rigid and comprising metal; said metal of said insulating member being configured to minimize heat conduction from said first portion of said pressure plate to said membrane spring...". The patent claims require that the insulating member comprise a metal portion and an additional portion and that the metal of the insulating member have a resistance to thermal conductivity that is greater than that of either the pressure plate or the membrane spring. Thus claim 8 is seen as attempting to recapture the broader scope surrendered in the application for the patent.

Claim R ejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claim 8 is rejected under 35 U.S.C. 102(a and e) as being anticipated by Hays('704). Hays discloses a single disc friction clutch comprising a clutch housing 12, a single clutch disc 14, a solid pressure plate 16, a friction lining 18 on the clutch disc, a membrane spring 30, and a thermal insulating member 44,56. The thermal insulating member is supported on the surface of the pressure plate between the pressure plate and the membrane spring, and is configured to minimize the contact between the thermal insulating member and the membrane spring (see column 6, lines 4-8). The thermal insulating member extends circumferentially about the pressure plate and has a first resistance to thermal conductivity. The membrane spring also inherently has a resistance to thermal conductivity. Since the thermal insulating member includes a

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molded plastic portion, it would have a higher resistance to thermal conductivity than that of the membrane spring. The thermal insulating member is rigid and comprises a metal, since the portion 44 is metal (column 6, lines 9-14). The metal of the insulating member is configured to minimize heat conduction from the pressure plate to the membrane spring (column 6, lines 4-8).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maycock et al.(European 0235882) in view of Reik et al.('710) and Heid et al.('120).

The Maycock et al. device shows all the conventional clutch structure including a cover 4, a pressure plate 12, clutch disc 22, and a membrane spring 10. A one-piece wire ring is interposed between the pressure plate and the spring in the Maycock et al. device for providing cushioning. Heid et al. shows that it is well known in the clutch art that heat conducted from the pressure plate can be detrimental to the spring and teaches providing means to reduce heat conduction to a coil spring. Reik et al. seeks to protect bearings from the heat conducted from the pressure plate and teaches providing a thermal barrier of plastic, ceramic, or metal. In Reik et al. the material of the thermal barrier would inherently have a higher resistance to thermal conductivity than at least

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one the members that it contacts in order to provide a thermal barrier. In view of Heid et al. and Reik et al., it would have been obvious to use a metal for the wire ring 42 of Maycock et al. that has a higher resistance to thermal conductivity than either the pressure plate or the spring, the motivation being to reduce the amount of heat conducted to the spring from the pressure plate.

Allowable Subject Matter

Claims 1-4 are allowed.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hays('688) is cited to show steel balls 44 between the pressure plate and membrane spring. Maycock et al.(Great Britain 2 222 439) is cited to show member 12 in Fig. 2.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rodney H. Bonck whose telephone number is (703)-308-2904. The examiner can normally be reached on Monday-Friday 7:30AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles A. Marmor can be reached on (703)-308-0830. The fax phone numbers for the organization where this application or proceeding is assigned are (703)-

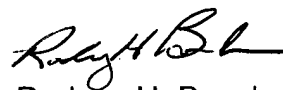
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305-3597 for regular communications and (703)-305-3597 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)- 308-1113.



Rodney H. Bonck
Primary Examiner
Art Unit 3681

rhb
February 11, 2002.